



Paper No. 5

ANNE B. KIERNAN
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7003

COPY MAILED

OCT 12 2001

OFFICE OF PETITIONS

~~In re Application of
Denwood F. Ross, et al.
Application No. 09/187,579
Filed: November 5, 1998
Attorney Docket No. VTN-423~~

DECISION GRANTING PETITION

~~In re Application of
Denwood F. Ross, et al.
Application No. 09/819,074
Filed: June 5, 2001
Attorney Docket No. VTN-423~~

This is a decision on the petition filed October 5, 2001, requesting that a Continued Prosecution Application (CPA) filed June 5, 2001, based on prior application No. 09/187,579 be treated as an application under 37 CFR 1.53(b) and accorded a filing date of June 5, 2001.

A review of the record discloses that a request for a CPA based on prior application No. 09/187,579 was deposited on June 5, 2001. Since the issue fee was paid in the prior application on April 26, 2001, a petition to withdraw the application from issue was also filed on June 5, 2001. However, the petition and the file of the prior application were not received by the appropriate official within sufficient time to avert issuance of the prior application as U.S. Patent No. 6,246,062 on June 12, 2001. Accordingly, the CPA request cannot be processed as a proper CPA under 37 CFR 1.53(d).

The present petition is filed in response to the decision mailed August 2, 2001 in the prior application. Petitioners request that the request for a CPA be treated as a continuation application filed under 37 CFR 1.53(b) and includes a copy of the specification, drawings and signed declaration from the prior application.

The petition is granted. Under the circumstances of this case, no petition fee is required.

The continuation application under 37 CFR 1.53(b) has been assigned Application No. 09/819,074. All further correspondence concerning the continuation application filed on June 5, 2001, should be directed to Application No. 09/819,074.

In view of this decision, the present petition (including the accompanying papers) and the CPA request and IDS filed on June 5, 2001, have been removed from the file of application No. 09/187,579 and placed in the file of application No. 09/819,074. A copy of the CPA request will be retained in the prior application. The basic filing fee of \$710.00 paid in Application No. 09/187,579 will be reapplied to the filing fee required in Application No. 09/819,074.

Since the petition under 37 CFR 1.313(c) was timely filed but a decision thereon was not rendered prior to the parent application issuing as a patent, the procedures set forth below should be followed by the examiner.

If the information disclosure statement (IDS) filed along with or referred to in the petition under 37 CFR 1.313(c) complies with the requirements of 37 CFR 1.97 and 1.98, it will be considered by the examiner in the continuing application filed under 37 CFR 1.53(b).

The examiner should make all applicable prior art rejections in the 37 CFR 1.53(b) application (not just include a statutory double patenting rejection under 35 U.S.C. 101) based on the information cited in the IDS, alone or with other information, including any new art found in updating an old search or performing a new search.

If the examiner determines that the information cited in the IDS, alone or in combination with other information does not raise a question of unpatentability with respect to the claims in the continuing application (which are identical to the claims in the parent patent), then the examiner should make a statutory double patenting rejection under 35 U.S.C. 101. Applicant may then abandon the continuing application.

If the examiner determines that the information cited in the IDS, alone or in combination with other information raises a prima facie case of unpatentability with respect to the claims in the continuing application (which are identical to the claims in the parent patent), then the examiner should make the appropriate prior art rejection along with the statutory double patenting rejection under 35 U.S.C. 101. If prosecution of the continuing application results in an amendment of the claims due to unpatentability, a statutory disclaimer of the unpatentable claims must be filed in the parent patent, and a terminal disclaimer can be filed in the continuing application if the amended claims would have been obvious over any claim of the parent patent so as to permit the continuing application to issue with the amended claims.

Prior Application No. 09/187,579 is being returned to the files repository.

Application No. 09/819,074 is being forwarded to Initial Patent Examination Division (OIPE) for processing as a continuation application under 37 CFR 1.53(b), not as a CPA under 37 CFR 1.53(d), with a filing date of June 5, 2001, using the copy of the specification, drawings and declaration supplied on October 5, 2001 and an indication on the filewrapper that the \$710.00 filing fee was paid on filing.

Telephone inquires related to this decision should be directed to the undersigned at (703) 305-9220. Telephone inquiries related to OIPE processing should be directed to their hotline at (703) 308-1202.

Sherry D. Brinkley
Sherry D. Brinkley
Petitions Examiner

Office of Petitions
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects